

REMARKS

Claims 15-32 are pending in this application. Claims 1-14 and 33-49 are canceled, herein. Claims 15-32 have been rejected. All cancellations are made without prejudice or disclaimer. Applicants respectfully traverse the rejections for the reasons expressed herein below.

A. Rejection of claims 47-49 under 35 U.S.C. § 112, second paragraph

Claims 47-49 are rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite. Although Applicants do not agree with the rejections, claims 47-49 have been canceled rendering the rejections thereof moot.

B. Declaration by Koutlakis

The Declaration of Koutlakis must be afforded its proper evidentiary weight. As stated in the MPEP, "[i]n assessing the probative value of an expert opinion, the [Patent Office] must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion." (M.P.E.P. § 716.01(b)(III)). Further, as stated by the Federal Circuit, "with respect to core factual findings in a determination of patentability... the [Patent Office] must point to some concrete evidence in the record in support of these findings." (In re Zurko, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001))

The Final Office Action states “this declaration, is not convincing because it is an opinion declaration. In addition, the declaration implies that the references are directed only to blasting media.” (Final Office Action, at page 3) (emphasis in original).

However, the Patent Office has not provided any objective reason to reject the expert opinion stated in the Declaration. The Declarant is a skilled artisan in the field and is providing an expert opinion as to how the products of the prior art would function based on the clumping ability and hardness of the products of the prior art. Further, the Koutlakis reference, on which the Patent Office is relying, is an invention by the present Declarant. Thus, the Declarant would clearly be an expert in interpreting the Declarant’s own invention. Accordingly, the Applicants respectfully submit that the Patent Office is not giving the evidence of record in the form of the Koutlakis Declaration its probative value. Accordingly, Applicants respectfully request reconsideration of the Declaration.

B. Rejection of claims under 35 U.S.C. § 103(a)

Claims 15-32 stand rejected as being assertedly obvious over Koutlakis et al. in view of Rosenflanz and Blanton et al. Lane et al. is also used in establishing some of the obviousness rejections. Applicants respectfully traverse the rejections as set forth herein.

A *prima facie* case of obviousness cannot be established. The *prima facie* case of obviousness asserted by the Final Office Action hinges on unsupported assumptions used to modify and/or interpret the cited references. The Final Office Action states “the references are not only limited to blasting media because Lane et al. (068) teaches an

example of abrasive application ... the reference states that the particles can be used in abrasive applications (i.e., this does not limit the reference to blasting media, but rather implies any abrasive application.) In addition, claim 1 of this reference [Lane et al.] only defines "grit" and also does not limit the claim to blasting media." (Final Office Action, pages 3-4). In characterizing Koutlakis et al., the Final Office Action states and assumes that "[a]lthough Koutlakis et al. only suggest blast media in the **examples** (reference is not limited to the examples), the claims of the reference do not limit the application, and as defined in the above rejection, the use of this grit as a milling (agitating) media would have been appreciated by the skilled artisan." (*Id.* at page 4). The Final Office Action further states and assumes that "why doesn't claim 1 define a method for producing blasting media? To the contrary, the claim defines a method for producing abrasive grit and the interpretation of abrasive grit is much broader than a blasting media." (*Id.*)

The Applicants respectfully submit that the statements in the Final Office Action used to modify and/or interpret the cited references in an attempt to form a *prima facie* case of obviousness are **unsupported assumptions** which are disputed by the evidence of record (i.e., the Declaration by Koutlakis). In establishing a *prima facie* case of obviousness, it must be determined whether substantial evidence exists to establish obviousness since the Federal Circuit has stated that the ultimate determination of obviousness is subject to substantial evidence standard. (See, In re Kotzab, 217 F3d 1365, 1369, 55 USPQ2d 1313 (Fed. Cir. 2000). "In reviewing the record for substantial evidence, we must take into account evidence that both justifies and detracts from the factual determination." (*Id.*) The Federal Circuit further indicated that

whether the Patent Office relies on express or inherent showings for obviousness, “broad conclusory statements standing alone are not ‘evidence.’” (*Id.* at 1370). “Rather, the [Patent Office] must point to some concrete evidence in the record in support of these findings.” (See, *In re Zurko*, *supra*).

The Applicants respectfully submit that when the evidence of the record is reviewed, the Declaration of Koutlakis clearly establishes that the blasting medium of Koutlakis et al. and Lane et al. could not be used as an agitating medium. (See, Declaration of Koutlakis, page 3). This substantial evidence of record supports the conclusion that obviousness cannot be established as opposed to the unsupported assumptions of the Final Office Action.

The theory relied on in the Final Office Action to establish obviousness not only assumes facts not in the record (i.e., by assuming what the cited references teach), it also relies on the theory of what is inherently taught or suggested in the references which is improper. “That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” (*In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, (Fed. Cir. 1993), *citing In re Spormann*, 53 C.C.P.A. 1375, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966)). Further, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (*M.P.E.P.* § 2112, *citing In re Rijckaert*, 9 F.3d at 1534, 28 USPQ 2d at 1957 (emphasis in original)). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’” (*Id.*, *citing In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Assuming, *arguendo*, that inherency could be used to establish obviousness, the Final Office Action has not met the standard for establishing inherency by assuming that the cited references teach what is not expressly stated. As stated by the Federal Circuit,

to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, **may not be established by probabilities or possibilities**. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

(MPEP § 2112, *quoting In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added)). Thus, for the Final Office Action to rely on what the cited references inherently teach, some form of evidence **must** be used to establish inherency.

Further, the United States Supreme Court has stated that "[i]f the [claimed invention was] accidentally and unwittingly produced, whilst the operators were in pursuit of other and different results, ... without its even being known what was done or how it had been done, it would be absurd to say that this was an anticipation of [the present invention]." (*Tilghman v. Proctor*, 261 U.S. 707, 711-712 (1980)).¹ This statement by the Supreme Court indicates that if something is inherent but not known, one of ordinary skill in the art could not be motivated by what is unknown.

Lastly, even if one of ordinary skill in the art would have been motivated to modify Lane et al. or Koutlakis et al. as asserted by the Final Office Action, a *prima facie* case of obviousness still would be defeated since there would be no reasonable expectation of success. The Koutlakis Declaration clearly establishes that the large glass-like

¹ Inherency must be recognized by a person of ordinary skill in the art, (see, *Cont'l Can Co. USA v. Monsanto Co.*, 20 USPQ.2d 1746, 1749-1750 (Fed. Cir. 1991)), which states "[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."

polysaccharides of the Koutlakis et al. reference used as a blasting media would destroy the substrate. (See, Koutlakis Declaration at page 3).

For all of the foregoing reasons and the reasons of record previously argued by the Applicants, the Applicants respectfully submit that a *prima facie* case of obviousness cannot be established. Thus, reconsideration and withdrawal of the obviousness rejections of claims 15-32 are requested.

II) Claims 15, 17, 18, 20, 22, 24, 26-27, and 47 are rejected under 35 U.S.C. § 103(a) for assertedly being obvious over Lane in view of Rosenflantz and Blanton. Applicants have cancelled claim 47 and traverse the rejection for the remaining claims for at least the following reasons.

The Declaration of Koutlakis points out that the skilled artisan would not infer that the disclosure of Koutlakis teaches agitating media. No evidence to the contrary has been presented, and, accordingly, Applicants respectfully request that the rejection be withdrawn.

III) Claims 16, 19, 21, 23, 25, 27-32 and 48-49 are rejected under 35 U.S.C. § 103(a) for assertedly being obvious over Lane, in view of Koutlakis, and further in view of Rosenflantz and Blanton. Applicants have cancelled claims 48-49 and traverse the rejection for the remaining claims for at least the following reasons.

Again, Applicants have submitted the Declaration of Koutlakis which points out that the skilled artisan would not infer that the disclosure of Koutlakis teaches agitating media. As discussed herein, no concrete evidence to the contrary has been presented in the Final Office Action; thus, Applicants respectfully request that the rejection be

withdrawn. Further, the disclosure of Lane *et al.* only teaches use of the particles in blasting applications at column 4, lines 7-9: "Treatments...include case hardening and abrasive applications." *Id.* at lines 7-8. This is a generic statement, which is clarified to be drawn to such examples including "projecting the particles against a surface to be treated, including entraining the particulates in a fluid flow...." *Id.* at lines 7-10. Such examples are clearly directed to "blasting," and there is no mention whatsoever that polysaccharide particles are useful in agitating applications. No evidence to the contrary has been presented, and, accordingly, Applicants respectfully request that the rejection be withdrawn.

Absent withdrawal of the rejections, Applicants reserve the right to appeal these and any other issues which have arisen during prosecution.

CONCLUSION

For at least the reasons discussed above, Applicants respectfully request reconsideration of the rejections of the claims. Applicants respectfully submit that the present claims are clearly distinguished over the prior art of record and are in proper form for allowance. In accordance, Applicants respectfully request allowance of the claims.

If the undersigned can be of assistance to the Examiner regarding any of the above, please contact the undersigned at the number set forth below.

Respectfully submitted,

9/22/06
Date



Mark R. Leslie
Reg. No. 36,360
Customer No. 41,835

KIRKPATRICK & LOCKHART Nicholson Graham LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222

Telephone: (412) 355-6271
Facsimile: (412) 355-6501